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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------------|-----------------------|------------------|
| 10/771,055 | 02/03/2004 | Reinhard Heinrich Hohensee | IBMN.004US01 (0502) | 1532 |
| 62626 7590 01/12/2007 DAVID W. LYNCH CHAMBLISS, BAHNER & STOPHEL 1000 TALLAN BUILDING-T TWO UNION SQUARE CHATTANOOGA, TN 37402 | | | EXAMINER KIM, PAUL | |
| | | | ART UNIT 2161 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 01/12/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/771,055

Applicant(s)

HOHENSEE ET AL.

Examiner

Paul Kim

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/3/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This Office action is responsive to the following communication: Response to Restriction Requirement filed on 02 October 2006.
2. Claims 1-18 and 26 are pending and present for examination. Claims 1 and 26 are independent.

Election/Restrictions

3. Applicant's election without traverse of claims 1-18 and 26 in the reply filed on 02 October 2006 is acknowledged.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 3 February 2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
6. **Claim 18** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 18 recites the negative limitation of "downloading the object without generating an error" which does not have basis in the original disclosure. For the purposes of this examination, prior art will not be applied to the present claim until further clarification is provided.

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7. **Claim 18** is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The step for when a download of the object should occur is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). This step is essential to the practice of the invention since, as disclosed in Paragraph [0069] of Applicant's Specification, "[t]wo conceptual methods are provided in a printer for holding downloaded resources: caching and capturing." Therefore, per Applicant's disclosure, in order for the caching or capturing of the objects to occur, the objects must have been previously downloaded. For the aforementioned reasons, the step of downloading the object is critical or essential to the practice of the invention. For the purposes of this examination, prior art will not be applied to the present claim until further clarification is provided.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 1-18** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed toward "a method for processing referenced objects," and are non-statutory because they do not encompass tangible subject matter and/or embodiments which fall within a statutory category.

The claims make no mention of a tangible medium wherein existing code may be processed to perform the recited steps in the claims. See *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. MPEP 2106. "The claimed invention as a whole must accomplish a practical application. That is, it must produce a 'useful, concrete and tangible result' " (emphasis added). That is, the claims fail to recite a method wherein a concrete and tangible result is produced since the method fails to further accomplish a result following the step of determining whether to capture the object.

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Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claims 1-17 and 26** are rejected under 35 U.S.C. 102(b) as being anticipated by Seto et al (U.S. Patent No. 5,546,572, hereinafter referred to as SETO), filed on 25 August 1992, and issued on 13 August 1996.

12. **As per independent claims 1 and 26**, SETO teaches:

A method for processing referenced objects, comprising:

referencing an object by selected indicia, the selected indicia being a name, a globally-unique identifier or a globally-unique identifier and an object locator {See SETO, C17:L51-61, wherein this reads over "[w]ith this command, the latitude and longitude of Shinjuku Station are retrieved from the object table by using the object name as a search key"};

searching for the object by the selected indicia {See SETO, C17:L51-61, wherein this reads over "[w]ith this command, the latitude and longitude of Shinjuku Station are retrieved from the object table by using the object name as a search key"}; and

determining whether to capture the object based upon whether the selected indicia includes a globally-unique identifier.

Additionally, the step of "determining whether to capture the object based upon whether the selected indicia includes a globally-unique identifier" is optional since wherein the selected indicia is a name, the selected indicia would then fail to include a globally-unique identifier. Therefore, the aforementioned step is optional and will not be afforded further consideration for the purposes of this Office action.

13. **As per dependent claim 2**, SETO teaches:

The method of claim 1 wherein the referencing of the object is by an object name and the searching for the object is performed by object name {See SETO, C17:L51-61, wherein this reads over "[w]ith this command, the latitude and longitude of Shinjuku Station are retrieved from the object table by using the object name as a search key"}.

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14. **As per dependent claims 3-17**, wherein the independent claim optionally recites "a globally-unique identifier" and "a globally-unique identifier and an object locator" and the claims recites an object that is referenced with said identifiers, the claims will not be further considered nor will prior art be applied.

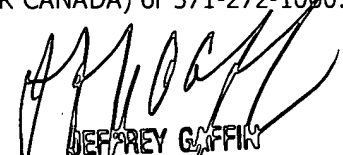
Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Kim whose telephone number is (571) 272-2737. The examiner can normally be reached on M-F, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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